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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/745,290

Applicant(s)

BERGER ET AL.

Examiner

Peter J. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: RCE amendment filed on 5/13/2005.
2. Claims 1-52 are pending in the case. Claims 1, 26, 27, 28, 33, and 43 are independent claims.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-24, 26-39, and 43-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al. (hereinafter “Tso”), US 6,421,733 B1 provisional filed 3/25/1997.**

**Regarding independent claim 1**, Tso discloses altering portions of a text of an original version of a digital document to produce a revised version of the digital document in which the text is shorter than the text of the original document in fig. 3, fig. 5, col. 1 lines 25-31, col. 2 lines 44-49, col. 3 line 45 – col. 4 line 47, and col. 8 lines 22-40. Tso discloses the altering being done based on a set of at least one preference, the set of at least one preference being associated with a device and independent of an association with the digital document in col. 7 lines 21-29 and col. 7 lines 43-54. Tso discloses receiving over a communication channel a request for the digital document from the device in fig. 1, fig. 3, fig. 5, and col. 2 lines 56-58. Tso discloses

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transmitting the revised version over the communication channel in response to the request in fig. 1, fig. 3, fig. 5, and col. 2 lines 56-58.

**Regarding dependent claim 2**, Tso discloses in which altering portions of the text includes applying more than one transformation selectively to the text in col. 8 lines 10-13.

**Regarding dependent claim 3**, Tso discloses selecting transformations to be applied to the text as part of the altering step, based on preferences associated with the device in col. 7 lines 21-29.

**Regarding dependent claim 4**, Tso discloses in which the preferences are associated with the device based on a unique identifier of the device in col. 7 lines 21-29.

**Regarding dependent claim 5**, Tso discloses in which the preferences are stored in advance of the request for a document in col. 6 line 64 – col. 8 line 13.

**Regarding dependent claim 6**, Tso discloses in which the preferences are stored in a database associated with a server in Tso discloses selecting transformations to be applied to the text as part of the altering step, based on preferences associated with the device in col. 6 line 64 – col. 8 line 13.

**Regarding dependent claim 7**, Tso discloses in which the preferences are indicated by a user through the interface of the device in fig. 4 and col. 11 lines 4-49.

**Regarding dependent claim 8**, Tso discloses in which the preferences are indicated by the user through the interface of a device other than the device from which the request for the digital document is made in fig. 4 and col. 11 lines 4-49.

**Regarding dependent claim 9**, Tso discloses in which the preferences are indicated on a form provided from a server in fig. 4 and col. 11 lines 4-49.

**Regarding dependent claim 10**, Tso discloses in which preferences are stored for each device from which requests for documents may be received in col. 7 lines 21-29.

**Regarding dependent claim 11**, Tso discloses in which preferences are stored for each type of device from which requests for documents may be received in col. 7 lines 21-29.

**Regarding dependent claim 12**, Tso discloses in which the preferences are stored on the device in fig. 5 and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claim 13**, Tso discloses in which the preferences are stored on the device using a cookie mechanism in col. 11 line 50 – col. 12 line 3.

**Regarding dependent claim 14**, Tso discloses in which the altering depends on the type of the device in col. 7 lines 21-29.

**Regarding dependent claim 15**, Tso discloses also including receiving information from the device identifying the type of device in col. 7 lines 21-29 and col. 11 line 50 – col. 12 line 3.

**Regarding dependent claim 16**, Tso discloses in which the altering is performed at a proxy server in fig. 3, fig. 5, and col. 3 lines 18-30.

**Regarding dependent claim 17**, Tso discloses in which the altering is performed at an origin server in col. 3 lines 18-30.

**Regarding dependent claim 18**, Tso discloses in which the device comprises a device that is not configured to display the entire document at one time in col. 7 lines 21-29 and col. 8 lines 22-40.

**Regarding dependent claim 19**, Tso discloses in which the device comprises a personal digital assistant, a hand-held device, or a telephone in col. 7 lines 21-29 and col. 8 lines 22-40.

**Regarding dependent claim 20**, Tso discloses in which the altering comprises date compression in col. 6 line 64 – col. 8 line 40.

**Regarding dependent claim 21**, Tso discloses in which the altering comprises word abbreviation in col. 6 line 64 – col. 8 line 40.

**Regarding dependent claim 22**, Tso discloses in which the altering comprises reducing the size of an image included in the original document in col. 6 line 64 – col. 8 line 40.

**Regarding dependent claim 23**, Tso discloses in which reducing includes image compression, resampling, or conversion from color to black-and-white in col. 6 line 64 – col. 8 line 40.

**Regarding dependent claim 24**, Tso discloses in which the digital document comprises a web page in fig. 3-5.

**Regarding independent claim 26**, Tso discloses maintaining a database that defines a plurality of sets of at least one preferences, wherein the sets of at least one preference are associated with different client devices in fig. 3, fig. 5, col. 1 lines 25-31, col. 2 lines 44-49, col. 3 line 45 – col. 4 line 47, and col. 8 lines 22-40. Tso discloses that the plurality of sets of at least one preferences are independent of an association with a web page and wherein the sets of at least one preference define preferred alterations to be performed on full web pages requested by respective client devices that are not configured to display full web pages, the alterations making the documents more suitable for display on the respective client devices col. 7 lines 21-29 and col. 7 lines 43-54.

**Regarding independent claim 27**, Tso discloses obtaining from a client device a set of at least one preferences with respect to preferred alterations to be performed on full documents

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requested by a client device that is not configured to display the full documents in fig. 3, fig. 5, col. 1 lines 25-31, col. 2 lines 44-49, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25. Tso discloses associating the set of preferences with the client device in a database, the set being associated with the client device independent of an association with a document in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding independent claim 28,** Tso discloses creating content for web pages to be served to types of clients that are not configured to display full web pages in col. 7 lines 21-29 and col. 8 lines 22-40. Tso discloses storing a plurality of sets of at least one preference defining at least one transformation that is to be made to the full web pages to make them suitable for display on the client devices, the stored sets of preferences each being associated with a respective device independent of an association with a web page, and defining at least one transformation to be made to full web pages requested by that respective device in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claim 29,** Tso discloses in which the digital document comprises an e-mail in col. 6 lines 37-41.

**Regarding dependent claim 30,** Tso discloses alter portions of a text based on preferences associated with a device and independent of an association with the digital document in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claim 31,** Tso discloses altering portions of a text based on preferences related to at least one capability of the device in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claim 32,** Tso discloses altering portions of a text based on preferences related to at least one capability of the device, and independent of a relation to an ability of a user of the device in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding independent claims 33 and 43,** Tso discloses receiving a set of at least one preference for altering digital documents to be displayed by a device, wherein the set of at least one preference is associated with the device and independent of an association with a digital document in col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25. Tso discloses altering at least a portion of an original version of a digital document based upon the set of at least one preference to thereby produce a revised version of the digital document and wherein the device is capable of displaying the revised version in fig. 3, fig. 5, col. 1 lines 25-31, col. 2 lines 44-49, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claims 34 and 44,** Tso discloses an origin server in col. 3 lines 18-30. Tso discloses transmitting the revised version of the digital document to the device after producing the revised version in fig. 1, fig. 3, fig. 5, and col. 2 lines 56-58.

**Regarding dependent claims 35 and 45,** Tso discloses receiving the original version of the digital document from an origin server in response to the origin server receiving a request for the digital document to be displayed by a device in fig. 1, fig. 3, fig. 5, and col. 2 lines 56-58.



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Tso discloses the original version of the digital of the digital document being independent of an association with a preference for altering at least a portion of the original version to thereby produce a revised version in fig. 3, fig. 5, col. 1 lines 25-31, col. 2 lines 44-49, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claims 36 and 46,** Tso discloses a proxy server which is capable of transmitting the revised version of the digital document to the device after producing the revised version in fig. 3, fig. 5, col. 3 lines 18-30, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claims 37 and 47,** Tso discloses a device which is capable of driving a display to present a revised version of the digital document after producing the revised version in fig. 3, fig. 5, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

**Regarding dependent claims 38 and 48,** Tso discloses in which the preferences are associated with the device based on a unique identifier of the device in col. 7 lines 21-29.

**Regarding dependent claims 39 and 49,** Tso discloses wherein the set of at least one preference is associated with a type of device and independent of an association with a digital document in fig. 3, fig. 5, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25. Tso discloses receiving the set of at least one preference based on the type of device for which the revised version of the digital document is produced in fig. 3, fig. 5, col. 3 line 45 – col. 4 line 47, col. 6 line 64 – col. 8 line 40, and col. 11 line 50 – col. 13 line 25.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 25, 40-42, and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al. (hereinafter "Tso"), US 6,421,733 B1 provisional filed 3/25/1997 in view of Tsimelzon, US 6,763,388 filed 8/10/1999.**

**Regarding dependent claim 25**, Tso discloses creating a subdocument containing less than all of the content information of the original digital document and transmitting the subdocument to the client in response to a request in col. 8 lines 22-40. Tso does not teach segmenting the digital document into subdocuments, and transmitting fewer than all of the subdocuments in response to the request. Tsimelzon does teach segmenting the digital document into subdocuments, and transmitting fewer than all of the subdocuments in response to the request in fig. 9, fig. 13, col. 2 lines 5-24, col. 2 lines 45-65, and col. 8 line 55 – col. 9 line 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tso and Tsimelzon to have created the claimed invention. It would have been obvious and desirable to have used the subdocument creation and transmission as taught by Tsimelzon to have improved the transcoding features of Tso so that a user would have had the option of receiving one of a plurality of subdocument revised versions as is taught by Tsimelzon instead of a single revised subdocument as is explicitly taught by Tso. This would have allowed the user to have viewed different subdocument parts of the original document as is taught by Tsimelzon in col. 8 line 55 – col. 9 line 5.

**Regarding dependent claims 40 and 50,** Tso discloses creating a subdocument containing less than all of the content information of the original digital document and transmitting the subdocument to the client in response to a request in col. 8 lines 22-40. Tso does not teach segmenting the digital document into subdocuments, and transmitting fewer than all of the subdocuments in response to the request. Tsimelzon does teach segmenting the digital document into subdocuments, and transmitting fewer than all of the subdocuments in response to the request in fig. 9, fig. 13, col. 2 lines 5-24, col. 2 lines 45-65, col. 8 line 55 – col. 9 line 5, and col. 10 line 37 – col. 11 line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tso and Tsimelzon to have created the claimed invention. It would have been obvious and desirable to have used the subdocument creation and transmission as taught by Tsimelzon to have improved the transcoding features of Tso so that a user would have had the option of receiving one of a plurality of subdocument revised versions as is taught by Tsimelzon instead of a single revised subdocument as is explicitly taught by Tso.

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This would have allowed the user to have viewed different subdocument parts of the original document as is taught by Tsimelzon in col. 8 line 55 – col. 9 line 5 and col. 10 line 37 – col. 11 line 20.

**Regarding dependent claims 41 and 51,** Tso does not teach segmenting the digital document into a plurality of ordered subdocuments, and wherein at least one of the portion of subdocuments transmitted to device includes a link to an adjacent subdocument retained by the network entity. Tsimelzon does teach segmenting the digital document into a plurality of ordered subdocuments, and wherein at least one of the portion of subdocuments transmitted to device includes a link to an adjacent subdocument retained by the network entity in fig. 9, fig. 13, col. 2 lines 5-24, col. 2 lines 45-65, col. 8 line 55 – col. 9 line 5, and col. 10 line 37 – col. 11 line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tso and Tsimelzon to have created the claimed invention. It would have been obvious and desirable to have used the subdocument creation and transmission as taught by Tsimelzon to have improved the transcoding features of Tso so that a user would have had the option of receiving one of a plurality of subdocument revised versions as is taught by Tsimelzon instead of a single revised subdocument as is explicitly taught by Tso. This would have allowed the user to have viewed different subdocument parts of the original document as is taught by Tsimelzon in col. 8 line 55 – col. 9 line 5 and col. 10 line 37 – col. 11 line 20.

**Regarding dependent claims 42 and 52,** Tso does not teach wherein at least one subdocument transmitted to the device includes a link such that, upon selection of the link, the

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processor is capable of receiving a request for the adjacent subdocument, and transmitting the adjacent subdocument to the device. Tsimelzon does teach wherein at least one subdocument transmitted to the device includes a link such that, upon selection of the link, the processor is capable of receiving a request for the adjacent subdocument, and transmitting the adjacent subdocument to the device in fig. 9, fig. 13, col. 2 lines 5-24, col. 2 lines 45-65, col. 8 line 55 – col. 9 line 5, and col. 10 line 37 – col. 11 line 20.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tso and Tsimelzon to have created the claimed invention. It would have been obvious and desirable to have used the subdocument creation and transmission as taught by Tsimelzon to have improved the transcoding features of Tso so that a user would have had the option of receiving one of a plurality of subdocument revised versions as is taught by Tsimelzon instead of a single revised subdocument as is explicitly taught by Tso. This would have allowed the user to have viewed different subdocument parts of the original document as is taught by Tsimelzon in col. 8 line 55 – col. 9 line 5 and col. 10 line 37 – col. 11 line 20.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new grounds of rejection. The Examiner has performed further in response to the amended limitations of previously presented claims 1-32 and the new limitations presented in claims 33-52. The Examiner has found and applied the prior art references of Tso et al. and Tsimelzon to teach the limitations of the invention as presented in claims 1-52.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Narayanaswamy, US 6,611,358 B1 filed 6/17/1997 discloses document transcoding for mobile stations. The invention can identify a particular mobile station's document display capabilities and modify a document according to the identified display capabilities before transmitting the document to the particular mobile station. Britton et al., US 6,654,814 B1 filed 1/26/1999 discloses dynamic placement of web content tailoring. Himmel, US 6,167,441 filed 11/21/1997 discloses customization of web pages based on requester type. Tso, US 6,742,047 B1 provisional filed 3/27/1997 discloses dynamically filtering network content. Mighdoll et al., US 5,918,013 filed 6/3/1996 discloses transcoding documents in a network environment using a proxy server. Mighdoll et al., US 6,662,218 B2 continuation of application filed 6/3/1996 discloses transcoding documents in a network environment using a proxy server. Kikinis, US 5,727,159 filed 4/10/1996 discloses a proxy-server which translates information received from the internet into a form/format readily usable by low power portable computers.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS

7/22/2005

  
WILLIAM BASHORE  
PRIMARY EXAMINER  
7/22/2005